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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,918	01/03/2002	Kenichi Iso	Q67868	2291

7590

07/07/2003

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EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,918

Applicant(s)

ISO ET AL.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imamura et al (5,282,689) in combination with Asao et al (5,804,536) or Fletcher (5,650,380).

Applicants' arguments filed 29 April have been fully considered but they are not persuasive. As previously set forth, Imamura et al ["Imamura"] disclose a roller bearing composed of an outer race, an inner race and rolling elements interposed between the outer race and the inner race, and wherein a lubricant composition is filled in the bearing. See column 1, line 60 to column 2, line 10. The lubricant composition comprises a polyphenyl ether base oil which has a kinematic viscosity of 90-160 cSt at 40°C. See column 2, lines 11-33. Applicants teach in the specification on pages 5 and 6 that ether-based oils including phenyl ether oils are suitable as the synthetic base oil in the invention. The lubricant composition of Imamura may contain a diurea thickener in an amount of 2 to 35 weight percent and may also contain known additives such as oxidation inhibitors, rust preventives, extreme pressure additives, etc. See column 5, line 20 to column 6, line 8. Applicants' invention differs by adding a metal naphthenate and/or a succinic acid derivative as a rust-preventative additive to the grease composition. However, the prior art references to Asao et al ["Asao"] and Fletcher show that these additives are conventional in grease compositions.

Asao disclose a solid lubricant for bearings which comprises a lubricating grease and polyethylene powder. Asao teaches that a rust preventive in the form of a sulfonate or a fatty polyhydric alcohol partial ester is added to the composition. See column 1, line 55 to column 2, line 24. Asao teaches that instead of or in combination with the fatty polyhydric alcohol partial ester, a half ester succinate may be used as the rust preventive agent. See column 3, lines 14-18, and claim 6. Fletcher discloses a lubricating grease composition suitable for use in constant velocity joints. The grease comprises a base oil, a urea compound thickener, conventional additives and zinc naphthenate in an amount of 0.05 to 12 percent by weight. See column 2, lines 46-55, and column 3, lines 20-31. Thus the examiner maintains the position that having the prior art references before the inventors at the time the invention was made, it would have been obvious to have added a known rust preventive additive, such as the half ester succinate of Asao, and the zinc naphthenate component of Fletcher to the composition of Imamura if their known imparted properties were so desired.

Applicants argue that the instant invention is remarkable for its function and advantage in preventing early flaking accompanying white structure change occurring when a rolling bearing is used under high temperature, high speed and high load conditions. Applicants argue that the inventors have found that a rust preventive additive generates considerable flaking accompanying the white structure change and that two specific rust preventing agents, a naphthenate and a succinic acid derivative, do not generate flaking accompanying the white structure change, and argue that Imamura is silent about the relationship between the additives and possible flaking accompanying the white structure change. This is not deemed to be

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persuasive of patentability because, as set forth above, Imamura allows for the addition of rust preventive additives to the composition, and for a *prima facie* case of obviousness to be established, the references need not recognize the problem solved by applicants. See **In re Kemps**, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996); **In re Beattie**, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). Applicants argue that Asao and Fletcher are also silent about the relationship between the additives and the flaking accompanying the white structure change. This is not deemed to be persuasive because Asao teaches a half ester succinate as a rust-preventive additive for grease compositions and Fletcher teaches a metal salt of naphthenic acid as a rust preventive additive for grease compositions, and a *prima facie* case of obviousness is still seen to exist. The examiner is of the position that with a factual foundation for its *prima facie* case of obviousness shown, the burden shifts to applicants to demonstrate that their claimed inventive grease composition possesses unexpected results. And that, unexpected results must be established by factual evidence, mere argument or conclusory statements do not suffice. See **In re Geisler**, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
July 1, 2003